

***United States Court of Appeals
for the Second Circuit***



**APPELLANT'S
REPLY BRIEF**

ORIGINAL

74-1774

United States Court of Appeals

For the Second Circuit

73 Civ. 4865

HERBERT ROSENTHAL JEWELRY CORPORATION,
Plaintiff-Appellant,
against

**HONORA JEWELRY CO., INC., JERRY J. GROSS-
BARDT and STANLEY SCHECHTER,**
Defendants-Appellees.

**ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK**

APPELLANT'S REPLY BRIEF

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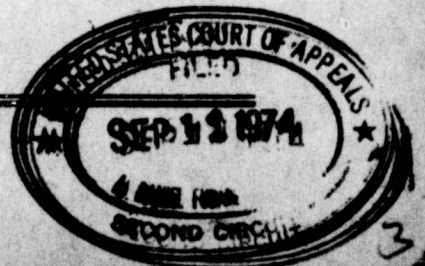


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On page 10 of their brief, appellees concede that the originality of plaintiff's design "is not at issue here". This concession supports appellant's contention that the Lower Court erred in holding that appellees were at liberty to employ the cluster of gems on the back of their turtle pin. Appellants agree with appellees' statement on page 9 of their brief that the "*design* of plaintiff's particular pin" is the issue here and its infringement by the defendants. This design consists of a cluster of precious gems on the back of a gold turtle. In urging dissimilarity between the two pins, appellees on pages 3 and 4 of their brief stress the structural differences between the pins, such as the thickness, construction, and weight of the gold of the respective pins. Nothing is said of the use by defendants of the same number of gems on the back of the turtle or the use by defendants of the same combination of stones as used by plaintiff (see page 2 of the Exhibit Book show-

ing the use of eight rubies and two diamonds on the back of the turtle). Apparently defendants' own customer Abercrombie & Fitch in illustrating defendants' pin in its catalog thought it important to stress the gems when it described defendants' pin as a "gold turtle plods along winningly, *its back loaded with rubies*" (Italics ours) Page 3 Exhibit Book.

Appellees urge that there can be no infringement in the absence of "copying". They contend that "Rosenthal has neither adduced nor alleged any evidence of copying at bar" (page 10 of appellees' brief). Apparently their interpretation of "evidence of copying" would be direct proof that someone actually saw defendants using plaintiff's pin as a model to fashion their own. While defendants in the prior suit admitted they did just that, the law does not require such proof in order to find "copying" and infringement. As Nimmer on Copyrights points out Sect. 141.2 page 613, "It is generally not possible to establish copying by direct evidence since it is rare that the plaintiff has available a witness to the act of copying" *Whitney v. Ross Jungnickel Inc.*, 179 F. Supp. 751 (S. D. N. Y. 1960). "Therefore copying is ordinarily established indirectly by the plaintiff's proof of access and substantial similarity" *Davis v. E. I. du Pont de Nemours & Co.*, 240 F. Supp. 612 (S. D. N. Y.); Nimmer on Copyrights page 613. Defendants had plaintiff's original pin which they admittedly acquired before the prior suit, so that there is no question of access. As for the similarity between the two pins, a mere comparison should convince this Court that substantial similarity exists between the pins under the guide lines set by this Court in the cases cited by appellant in its main brief. The Lower Court, as do the appellees here point to minor differences in the construction of the two pins but it is the overall appearance of the pins and the attention the average purchaser would pay to the design which is

the true test of similarity. In *Concord Fabrics Inc. v. Marcus Bros. Textile Corp.*, 409 F. 2d 1315 (2d Cir. 1969) this Court appropriately stated:

“While the trial court placed great emphasis on the minor differences between the two design patterns, we feel that the very nature of these differences only tends to emphasize the extent to which the defendant has deliberately copied from the plaintiff.”

This Court's decision in *Comptone Co. v. Rayex Corp.*, 251 F. 2d 487 (C. A. 2, 1958) aptly meets the situation here, there the Court stated:

“Defendant admittedly copied plaintiff's copyrighted sun glass advertising card. Later defendant issued a second card retaining features of the first but making some changes. It is to the defendant's second card that the orders on appeal are directed. There is still a substantial similarity in the effect obtained from the shape of the card, the legends, the price sign and *the use of the Eiffel Tower* in a somewhat similar treatment, sufficient to sustain the court's Finding No. 8 of infringement. The copying need not be of every detail so long as the copy is substantially similar to the copyrighted work” (italics ours).

Prof. Nimmer in his book on Copyrights page 614 Sect. 141.2 further suggests “In evaluating the defendant's claim of independent creation, the trier may properly consider the defendant's past conduct in independently creating works (*Malkin v. Dubinsky*, 203 N. Y. S. 2d 501 (1960)) or conversely, his record of copying in other instances”. *Hass v. Leo Feist Inc.*, 234 Fed. 105 (S. D. N. Y. 1916).

Defendants as a partnership were enjoined on two occasions by the District Court below and on appeal to this Court for admittedly copying plaintiff's jeweled turtle and bee pins *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 428 F. 2d 551; *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 436 F. 2d 315. In addition the defendants were sued by Kurt Wayne, Inc., in this district 72 Civ. 1089 for infringement of a copyright on a ring. The suit was terminated by a consent decree wherein defendants admitted the validity of the copyright, agreed to refrain from manufacturing and selling the ring, and to deliver up for destruction all molds, castings, etc. for making the ring. Counsel for appellees here, represented the defendants in that suit. Defendants were also involved in a suit brought by *Van Cleef & Arpels*, 308 F. Supp. 674 in this District for infringement of copyrighted jewelry. This suit was determined in favor of the defendants because plaintiff there could not prove title to the jewelry.

The proof before this Court should convince it that defendants are not innocent creators of the turtle in suit but deliberate and willful infringers. The judgment of the Court below should be reversed and judgment directed for the plaintiff. *Sheldon v. Metro Goldwyn Mayer*, 81 F. 2d 49 (C. A. 2, 1936).

Respectfully submitted,

CHARLES SONNENREICH,
Attorney for Plaintiff-Appellant.

Two (2)
Due and timely service of three (3) copies of
the within ~~document~~ is hereby admitted this
11th day of September, 1977

Pollack & Singer

Attorney for

Defendant-Appellee